

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION		DOCKET No.:	PF 53325
OF:	AMMERMAN ET AL.	CONFIRMATION No.:	2835
SERIAL NO.	10/506,502	GROUP ART UNIT:	1616
FILED:	SEPTEMBER 03, 2004	EXAMINER:	A. N. PRYOR
FOR:	FUNGICIDAL MIXTURES BASED ON PROTHIOCONAZOLE AND CONTAINING AN INSECTICIDE		

TO: HONORABLE COMMISSIONER FOR PATENTS
P.O. BOX 1450, ALEXANDRIA, VA 22313-1450

BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Sir:

- ☐ NOTICE OF APPEAL: Applicant hereby appeals to the Board of Appeals from the decision dated -/-, of the Primary Examiner finally rejecting Claims -/-.
- ☒ BRIEF ON APPEAL in this application is transmitted herewith.
☐ Applicants hereby request an Oral Hearing.
- ☒ Applicants hereby request entry of their timely replies dated July 12, 2007, August 22, 2007, and October 22, 2007, for purposes of appeal.
- ☒ Applicants hereby petition for -5- month extensions of time under 37 C.F.R. §1.136(a).
☒ Petitions for a total of -4- month extensions of time including fees in the total amount of -\$1760.00- have previously been submitted since July 12, 2007.
- ☒ The following fee(s) in the total amount of -\$ 980.00- is(are) paid herewith by credit card:
☒ The \$ 510.00 fee required under 37 C.F.R. §41.20(b)(2).
☐ The -/- fee required under 37 C.F.R. §41.20(b)(3).
☒ The \$ 470.00 fee required under 37 C.F.R. §1.17(a).
☐ A fee is not required (Fee paid in prior appeal).
- ☒ The Commissioner is hereby authorized to charge any fee which may be further required, or credit any over payment, to Deposit Account No. 14.1437. A duplicate copy of this sheet is attached.

Respectfully submitted,
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Honorable Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Sir:

This is an appeal from the Examiner's final rejection of Claims 10 and 11, dated November 14, 2006. Claims 1 to 6 and 8, 9, 12 and 13 are currently pending. Claims 12 and 13 correspond to Claims 10 and 11 which were finally rejected by the Examiner.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,
NOVAK DRUCE DELUCA & QUIGG

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REAL PARTY IN INTEREST

The real party in interest is BASF Aktiengesellschaft, 67056 Ludwigshafen, Germany.

RELATED APPEALS AND INTERFERENCES

To the best of the undersigned's knowledge, there are no related appeals or interferences within the meaning of 37 C.F.R. §41.37(c)(1)(ii).

STATUS OF THE CLAIMS

The claims on appeal before the Board of Patent Appeals and Interferences are Claims 1 to 6 and 8, 9, 12 and 13. A copy of these claims is found in the attached Claims Appendix. The status of the claims is as follows:

- Claim(s) 1 to 6, 8, 9, 12 and 13 is(are) pending;
- Claim(s) 7 is(are) canceled;
- Claim(s) 12 and 13, which correspond to Claims 10 and 11, is(are) rejected;
- Claim(s) 1 to 6, 8 and 9 is(are) allowed;
- Claim(s) -/- is(are) withdrawn; and
- Claim(s) -/- is(are) objected to.

STATUS OF THE AMENDMENTS

The claims as currently pending are based on the claims presented with appellants' paper dated February 02, 2007, in reply to the final Office action dated November 14, 2006. Entry of the amendment was indicated in the Examiner's advisory action dated May 04, 2007.

On July 12, 2007, appellants presented a supplemental reply canceling Claims 10 and 11. Entry and consideration of the respective paper was not confirmed in writing. However, the Examiner indicated in a telephone interview on August 22, 2007, that Claims 10 and 11 should be re-instated, and that clarification of the expression "adducts" in Claim 1 was required to place the application in condition for allowance.

Accordingly, appellants presented a supplemental paper revising Claim 1 and re-introducing Claims 10 and 11 as new Claims 12 and 13, on August 22, 2007. Entry and consideration of the respective paper was not confirmed in writing. However, the Examiner indicated in a telephone in-

interview on October 09, 2007, that formula (III) in Claims 1 and 12 should be corrected to place the application in condition for allowance.

Accordingly, appellants presented a supplemental paper correcting Claims 1 and 12 on October 09, 2007. Entry and consideration of the respective paper was not confirmed in writing. However, in a further telephone interview on October 22, 2007, the Examiner sought authorization for an Examiner's Amendment effecting the following changes to place the application in condition for allowance:

- 1) A revision of the paragraph on page 7, indicated lines 37 to 39, of the application to include a sentence reflecting the subject matter of Claim 9 for proper antecedent basis.
- 2) A revision of Claim 6 to delete the definite article preceding the phrase "*plants, seeds, soils and materials ...*"
- 3) A revision of Claim 12 to read: "*which comprises treating ... the said fungi ~~with~~ ^{by applying} synergistically effective amounts of a mixture of ... wherein the components are applied simultaneously, ...*"

Authorization was given by appellants' representative during the telephone interview. The claims presently pending in the application are therefore deemed to be Claims 1 to 6, 8, 9, 12 and 13 as presented with appellants' submission dated October 09, 2007, and as further amended in the manner authorized by appellants' representative during the telephone interview of October 22, 2007.

SUMMARY OF THE CLAIMED SUBJECT MATTER

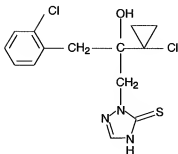
The sole independent claim involved in the appeal is Claim 12 which corresponds to Claim 10 as addressed by the Examiner in the final Office action of November 14, 2006. Claim 13, which corresponds to Claim 11, depends upon Claim 12 and will not be argued separately in this paper. A summary of the embodiments defined by Claim 13 is therefore deemed to be unnecessary.¹⁾

Appellants' invention as defined in Claim 12 pertains to a method for controlling harmful fungi, which comprises treating the harmful fungi, their habitat or plants, seeds, soils, areas, materials or spaces to be kept free from said fungi with effective amounts of a certain synergistic mixture. The synergistic mixture is composed of:²⁾

- (A) a compound of the formula I

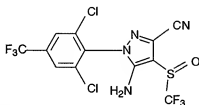
1) 37 C.F.R. §41.37(v).

2) Cf., e.g., page 1, indicated line 4, to page 2, indicated line 8, in conjunction with page 2, indicated line 41, to page 3, indicated line 2, of the application.

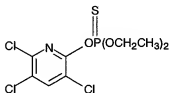


or a salt or adduct thereof with an inorganic or organic acid or with metal ions, and

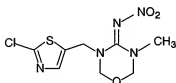
- (B) at least one insecticide selected from the group consisting of
a compound of the formula II,



a compound of the formula III



and a compound of the formula IV



and the method can be conducted by applying the components of the synergistic mixture to the targets simultaneously, that is together or separately, or in succession.³⁾

GROUND(S) OF REJECTION TO BE REVIEWED

Whether the Examiner erred finding that the subject matter of appellants' Claims 10 and 11, in the version of current Claims 12 and 13, was unpatentable under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement.

3) Cf., e.g., page 2, indicated line 43, to page 3, indicated line 2, page 5, indicated lines 28 to 35, page 6, indicated lines 18 to 22, page 7, indicated lines 17 to 32, page 8, indicated lines 11 to 14 and indicated lines 37 to 43, and page 9, indicated lines 6 to 9, of the application.

ARGUMENT(S)

The Examiner's finding that the subject matter of appellants' Claims 10 and 11, in the version of current Claims 12 and 13, was unpatentable under 35 U.S.C. §112, ¶1, for failing to comply with the written description requirement is, for the following reasons, deemed to be in error.

To satisfy the written description requirement, an application must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor(s) had possession of the claimed invention.⁴⁾ An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.⁵⁾ Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention.⁶⁾ There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed, and "*the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.*"⁷⁾

Claim 12 which corresponds to Claim 10 is drawn to the subject matter of original Claim 7 the difference being that Claim 12 is in independent form whereas Claim 7 incorporated the features of Claim 6, and indirectly the pertinent elements of Claim 1, by reference. The wording of original Claim 7 clearly conveys to a person having ordinary skill in the pertinent art that appellants' method employs, on the one hand, quasi "*pre-mixed*" combinations of the respective compounds in the requisite amounts, and on the other hand, combinations which are obtained quasi "*in situ*" when the requisite amounts of the respective compounds are applied to the target separately either simultaneously or in succession. The equivalence of quasi "*pre-formed*" and quasi "*in situ*" formed mixtures is expressed throughout the application:

Moreover, the invention relates to a method for controlling harmful fungi using mixtures of the compound I with at least one of the compounds II, III or IV and to the use of compounds

4) See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

5) *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

6) See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406; *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991).

7) *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).

I, II, III and IV for preparing such mixtures, and to compositions comprising these mixtures.⁸⁾

Moreover, we have found that applying the compound I simultaneously, that is together or separately, with at least one further compound II, III or IV or applying the compound I with at least one of the compounds II, III or IV in succession provides better control of harmful fungi than is possible with the individual compounds alone.⁹⁾

The mixtures of the compound I with at least one of the compounds II, III and IV, or the compound I and at least one of the compounds II, III and IV applied simultaneously, together or separately, exhibit outstanding activity against a wide range of phytopathogenic fungi, ...¹⁰⁾

The compound I and at least one of the compounds II, III and IV can be applied simultaneously, that is together or separately, or in succession, the sequence, in the case of separate application, generally not having any effect on the result of the control measures.¹¹⁾

If phytopathogenic harmful fungi are to be controlled, the separate or joint application of the compound I and at least one of the compounds II, III and IV or of the mixtures of the compound I with at least one of the compounds II, III or IV is effected by ...¹²⁾

The fungicidal synergistic mixtures according to the invention or the compound I and at least one of the compounds II, III and IV can be formulated, for example, in the form of ...¹³⁾

The compounds I, II, III and IV, the mixtures, or the corresponding formulations, are applied by treating the harmful fungi, their habitat, or the plants, seeds, soils, areas, materials or spaces to be kept free from them with a fungicidally effective amount of the mixture, or of the compound I and at least one of the compounds II, III or IV in the case of separate application.¹⁴⁾

A person of ordinary skill in the art is, at least in light of the foregoing sections, clearly fully apprised of the fact that appellants' disclosure does not distinguish between the application of a "pre-formed" mixture and the application of the components in such a manner that the synergistic mixture is formed in situ. A person of ordinary skill is, therefore, also fully apprised by appellants'

8) Page 2, indicated lines 10 to 14, of the application.

9) Page 2, indicated line 43, to page 3, indicated line 2, of the application; emphasis added.

10) Page 5, indicated lines 28 to 31, of the application; emphasis added.

11) Page 6, indicated lines 18 to 22, of the application.

12) Page 7, indicated lines 17 to 21, of the application; emphasis added.

13) Page 7, indicated lines 25 to 27, of the application.

14) Page 8, indicated lines 37 to 43, of the application.

disclosure that the object of the invention “to provide ... (synergistic mixtures),”¹⁵⁾ is achieved irrespective of whether the respective compounds in the requisite amounts are provided in a “*pre-mixed*” combination or are combined “*in situ*” by applying the requisite amounts of the respective compounds to the target separately either simultaneously or in succession.¹⁶⁾

The Examiner argued that the phrases “*better control*” and “*outstanding activity*” which are inter alia used on pages 2, 3 and 5 of the application fail to indicate synergistic effects. It is, however, immediately apparent from the context in which those expressions are used in appellants’ disclosure that the respective effects are inherent in the combination of the requisite amounts of the respective compounds and are, as such, not dependent on whether the combination takes place prior to the application, or takes place quasi in situ, i.e. after both components have been applied to the target(s) in the requisite amounts. Accordingly, the “*better control*” and “*outstanding activity*” correspond to the “*improved activity against harmful fungi combined with a reduced total amount of active compounds applied (synergistic mixtures)*.” The Examiner’s respective position is therefore not deemed to be well taken. Also, the Examiner’s position that “[t]he specification does not provide a written description of synergism where the compounds I and II, III or IV are applied separately or successively”¹⁷⁾ is, in light of the foregoing, deemed to be clearly in error.

It is respectfully urged that the Examiner’s arguments are insufficient to establish that a person of ordinary skill in the art would not recognize in the disclosure of the invention which is provided by appellants a description of the invention which was originally defined in Claim 7 and which is now presented in independent form in Claim 12.

CONCLUSION

In light of the foregoing reasons and explanations as well as the explanations already presented by appellants in their paper dated February 06, 2007,¹⁸⁾ appellants respectfully urge that the Examiner’s rejections of Claims 10 and 11, in the version of current Claims 12 and 13, under 35 U.S.C. §112, ¶1, was in error. It is therefore respectfully requested that the Examiner’s respective rejection be reversed. Favorable action is solicited.

15) Page 2, indicated lines 34 to 37, of the application.

16) Cf. e.g. page 2, indicated line 41, to page 3, indicated line 2, of the application.

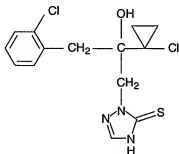
17) Office action page 3, lines 13 and 14; cf. also page 3, lines 17 to 20.

18) The respective paper is herewith incorporated by reference.

CLAIMS APPENDIX:

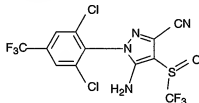
1. A fungicidal mixture, comprising

- (1) 2-[2-(1-chlorocyclopropyl)-3-(2-chlorophenyl)-2-hydroxypropyl]-2,4-dihydro-[1,2,4]-triazole-3-thione (prothioconazole) of the formula I or its salts or adducts with inorganic or organic acids or with metal ions



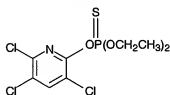
and at least one insecticide selected from the group consisting of

- (2) fipronil of the formula II



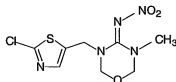
or

- (3) chlorpyrifos of the formula III



or

- (4) thiamethoxam of the formula IV

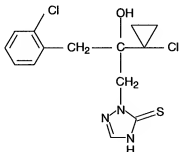


in a synergistically effective amount.

2. A fungicidal mixture as claimed in claim 1, comprising prothioconazole of the formula I and fipronil of the formula II.

3. A fungicidal mixture as claimed in claim 1, comprising prothioco-nazole of the formula I and chlorpyrifos of the formula III.
4. A fungicidal mixture as claimed in claim 1, comprising prothioco-nazole of the formula I and thiamethoxam of the formula IV.
5. A fungicidal mixture as claimed in claim 1, wherein the weight ratio of prothioconazole of the formula I to
 - fipronil of the formula II is from 20 : 1 to 1 : 20,
 - chlorpyrifos of the formula III is from 20 : 1 to 1 : 20 and
 - thiamethoxam of the formula IV is from 20 : 1 to 1 : 20.
6. A method for controlling harmful fungi, which comprises treating the harmful fungi, their habitat or plants, seeds, soils, areas, materials or spaces to be kept free from them with the fungicidal mixture as claimed in claim 1.
7. (canceled)
8. A method as claimed in claim 6, wherein the fungicidal mixture is applied in an amount of from 0.01 to 8 kg/ha.
9. A fungicidal composition, comprising the fungicidal mixture as claimed in claim 1 and a solid or liquid carrier.
10. - 11. (canceled)
12. A method for controlling harmful fungi, which comprises treating the harmful fungi, their habitat or plants, seeds, soils, areas, materials or spaces to be kept free from said fungi with syner-gistically effective amounts of a mixture of:

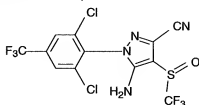
a compound of the formula I



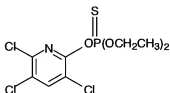
or a salt or adduct thereof with an inorganic or organic acid or with metal ions,

and at least one insecticide selected from the group consisting of

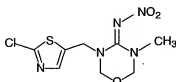
a compound of the formula II,



a compound of the formula III



and a compound of the formula IV



wherein the compounds are applied simultaneously, that is together or separately, or in succession.

13. The method as claimed in claim 12, wherein the compound of formula I and the at least one compound of the formula II, formula III or formula IV are applied in an amount of from 0.01 to 8 Kg/ha.

EVIDENCE APPENDIX:

N O N E

RELATED PROCEEDINGS APPENDIX:

N O N E